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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,019	08/30/2001	Yuan-Wan Ku	148693.00389	9527

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EXAMINER

TUCKER, WESLEY J

ART UNIT PAPER NUMBER

2623

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/943,019	<b>Applicant(s)</b> KU, YUAN-WAN	
	<b>Examiner</b> Wes Tucker	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood how the sensing loop can be located on two opposite faces of the tablet.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-4, 6, 7, and 9-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,689,965 to Fleck.

With regard to claim 1, Fleck discloses a handwriting recognition system, comprising a wireless pen, said wireless pen comprising an eraser mode button, said handwriting recognition system performing an eraser mode while said eraser mode button being pressed (column 6, lines 26-55). The eraser mode button is interpreted as the tip of the eraser because the pen is in eraser mode whenever the pen eraser tip is pressed and performs erasing operations.

Fleck further discloses a tablet, said tablet receiving a plurality of messages to decide the location of said wireless pen and the corresponding mode of said handwriting recognition system, said messages are transmitted from said wireless pen (column 5, lines 56-65). Here the pen's location is determined with regard to a tablet and the position of the pen is displayed on a display. The mode of the pen is also selected.

With regard to claim 2, Fleck discloses the handwriting recognition system of claim 1, said handwriting recognition system performing a writing mode while said eraser mode being relaxed (column 5, lines 56-61). Here Fleck discloses that the user is able to select writing or erasing or selecting mode. So when one mode is selected the other modes are relaxed.

With regard to claim 3, Fleck discloses the handwriting recognition system of claim 1, while the distance between said wireless pen and said tablet exceeding predetermined distance during a predetermined period, said eraser

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button being automatically relaxed and then said handwriting recognition system automatically escaping said eraser mode (column 7, lines 53-58). Fleck discloses that the writing tip of the pen is outside a sensing distance and it is understood that when the eraser tip is removed from the tablet a certain distance that the erasing mode will no longer be active.

With regard to claim 4, Fleck discloses the handwriting recognition system of claim 3 said handwriting recognition system automatically escaping said eraser button mode and performing a writing mode (column 7, lines 16-25 and 54-59). Fleck discloses that the two different tips of the pen (erasing and writing) emit the same frequency signal and that only one end will be in the sensing range of the tablet. So it follows that when the pen is turned around and the erasing tip is removed and the writing tip replaces it in the range of the template, the writing mode is enabled and the erasing mode automatically relaxed.

With regard to claim 6, Fleck discloses the handwriting recognition system of claim 1, the frequency of said handwriting recognition system being changed while the corresponding mode of said handwriting recognition system being changed (column 7, lines 14-25).

With regard to claim 7, Fleck discloses the handwriting recognition system of claim 1, said tablet comprising a sensing loop (column 7, lines 26-38).

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With regard to claim 9, Fleck discloses the handwriting recognition system of claim 7, said sensing loop being divided into an X-axis system and Y-axis system (column 7, lines 26-38).

With regard to claim 10, Fleck discloses the handwriting recognition system of claim 1 said wireless pen having only one coil, said coil connecting with an eraser mode capacitor while said eraser mode being pressed, and said coil being separating away said eraser mode capacitor while said eraser button being relaxed (column 7, lines 1-12). Fleck discloses a single coil 41 in the pen for determining the mode of the pen.

With regard to claim 11, Fleck discloses a wireless pen, comprising an eraser mode capacitor (column 6, lines 27-55), and a writing mode capacitor, the capacitance of said writing mode being different to the capacitance of said eraser mode capacitor (column 6, line 62-column 7, line 12).

Fleck further discloses a coil, which is located in one terminal of said wireless pen (Fig. 7A, element 39).

Fleck further discloses an eraser mode button, said coil being only connected with said eraser mode capacitor while said eraser mode button being pressed, and a writing mode button, said coil being only connected with said writing mode capacitor while said writing mode button being pressed (column 7, lines 1-12).

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With regard to claim 12, Fleck discloses the wireless pen of claim 11, the frequency of the electromagnetic wave produced by the connection between said coil and said eraser mode capacitor being different to the frequency of the electromagnetic wave produced by the connection between said coil and said writing mode capacitor (column 7, lines 1-12).

With regard to claim 13, Fleck discloses the wireless pen of claim 11, the function of said wireless pen being like on an eraser while said eraser mode button being pressed (column 5, lines 55-67). Fleck discloses the switching of different modes that the stylus is capable of operating in.

With regard to claim 14, Fleck discloses the wireless pen of claim 11, the function of said wireless pen being like on a pen while said writing mode button being pressed (column 5, lines 55-67). Fleck discloses the switching of different modes that the stylus is capable of operating in.

With regard to claim 15, Fleck discloses the wireless pen of claim both said eraser mode button and said writing mode button being providing by a mode switch button (column 7, lines 10-14), said coil being connected with said eraser mode capacitor while said mode switch button being pressed, and said coil being connected with said writing mode capacitor while said mode switch button being relaxed (column 6, line 57-column 7, line 13).



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With regard to claim 16, Fleck discloses the wireless pen of claim 11, both said eraser mode button and said writing mode button being providing by a mode switch button (column 7, lines 10-14), said coil being connected with said eraser mode capacitor while said mode switch button being relaxed, and said coil being connected with said writing mode capacitor while said mode switch button being pressed (column 6, line 57-column 7, line 13).

With regard to claim 17, Fleck discloses the wireless pen of claim 11, both said eraser mode button and said writing mode button being providing by a mode switch device (column 7, lines 10-14), said coil being connected with said eraser mode capacitor while said mode switch button being switched to said eraser mode, and said coil being connected with said writing mode capacitor while said mode switch button being switched to said writing mode (column 6, line 57-column 7, line 13).

With regard to claim 18, Fleck discloses a method of using a handwriting recognition system comprising turning on a tablet and a wireless pen, said tablet being used to receive a plurality of messages which are transmitted from said wireless pen (column 5, lines 55-67).

Fleck further discloses moving said wireless pen over said tablet so let said message be received by said tablet, and switching the current mode of said handwriting recognition system, wherein the terminal with coil of said wireless

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pen always is more closed to said tablet than the other terminal (column 5, lines 55-67).

With regard to claim 19, Fleck discloses the method of claim 18, further comprising the step of pressing an erase mode button to activate an eraser mode and the step of pressing a writing mode button to activate a writing mode, wherein both said eraser mode button and said writing mode button are located in and on said wireless pen (column 5, lines 55-67).

With regard to claim 20, Fleck discloses the method of claim 18, further comprising the step of changing the distance between said wireless pen and said tablet to change the strength of said messages, wherein current mode of said handwriting recognition system being switched whenever the strength of message being less a predetermined strength (column 6, lines 27-56). Here the pressure of the pen to the tablet is matched with a threshold and if the threshold is broken functions are performed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,689,965 to Fleck.

With regard to claim 5, Fleck discloses the handwriting system of claim 3, but does not disclose a predetermined period being about 2 to 3 seconds. However it is well known in the art of computer controlled devices to have a timeout period such as 2 to 3 seconds in order to save power and processing resources. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to have a timeout function in order to escape a writing/erasing mode while the pen has been removed from the pad in order to save power and processing resources.

With regard to claim 8, Fleck discloses the handwriting recognition of claim 7, with said sensing loop, but does not disclose the sensing loop being located on the two opposite faces of tablet. However if the loop is active on one side of the tablet, it follows that the same loop could be used on the opposite side of the face as well if the surface were thin enough. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use the same sensing loop for use on both opposite faces of the tablet in order to enable writing on both surfaces as long as the surface is thin enough to enable sensing on both sides from the same loop.

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### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wes Tucker whose telephone number is 703-305-6700. The examiner can normally be reached on 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703)308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wes Tucker

8-16-2004

  
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